

REMARKS/ARGUMENTS

This communication is in response to the Non-Final Office Action dated July 6, 2009. Claims 2 and 15 have been amended. No new matter has been added. Claims 1-16 remain pending in this application with claims 1 and 12 being the only independent claims. Reconsideration is respectfully requested.

Priority Under §119

On the form PTOL-326, paragraph 12, the Examiner indicates that only “some” of the certified copies of the foreign priority documents have been received. Applicant properly indicated priority to German Patent Application No. 103 14915.5 in the ADS on September 28, 2005, when the National Stage Application was filed and claimed priority to German Patent Application No. 103 14915.5 in the Declaration submitted on January 29, 2007. Since, as stated, the present application was a national stage application under 35 U.S.C. §317 of PCT International No. PCT/DE04/00702, filed on April 1, 2004, a certified copy of the priority document need not be submitted since it was timely furnished in the international phase and thus should have been provided to the US Patent Office by WIPO (see Image File Wrapper of September 28, 2005, where the Certified Copy of foreign Priority can be found). Acknowledgement by the Examiner in the next communication that “all” of the certified copies of the priority documents have been received is requested.

Prior Art Rejections

Claims 12-14 and 16 are rejected under 35 U.S.C. §103(a) as obvious over Laumen et al. (US Patent Application Publication No. 2003/0086438) in view of Fenton (US Patent Application Publication No. 2003/0193951).

Note: The Examiner grouped claim 16 into this first set of prior art rejections, however, claim 16 is rejected on the same grounds as that of claim 7 which is included in the second set of prior art rejections below.

Claims 1-8 and 10-15 are rejected under 35 U.S.C. §103(a) as obvious over Laumen et al.

in view of Gabriel et al. (U.S. Patent Application Publication No.: 2004/0082348) and Fenton.

Note: The Examiner grouped claims 12-14 into this second set of prior art rejections, however, it is only included in the first set of prior art rejections. Therefore, this second set of prior art rejections should read “Claims 1-8, 10, 11, 15 and 16.”

Claim 9 is rejected under 35 U.S.C. §103(a) as obvious over Laumen et al. and Gabriel et al. in view of Ala-Luukko et al. (U.S. Patent Application Publication No.: 2003/0064706).

Applicant respectfully traverses the prior art rejections for the reasons discussed in detail below.

Independent Claim 1

Independent claim 1 specifies “wherein the e-mail is transmitted from a sender via a polled e-mail server to the recipient” and that “the e-mails are forwarded from the polled e-mail server to a specially configured push mail server.”

The Examiner maintains that RSA 2 reads on the claimed “polled e-mail server”, while RSB 12 reads on the claimed “push mail server.” Applicant respectfully disagrees. These two elements (e.g., RSA and RSB) represent the same type of element, i.e., both are MMS Relay/Servers. Since both of these elements represent the same type of component (e.g., MMS Relay/Server) one cannot represent a polled e-mail server while the other represents a push mail server. To the contrary, both RSA and RSB represent two push mail servers. Accordingly, Laumen et al. fails to disclose or suggest “a polled e-mail server.”

The Examiner acknowledges that Laumen et al. fails to disclose “a polled e-mail server” but submits that Fenton teaches this missing limitation. Applicant submits that modification of Laumen et al. as taught by Fenton to include one polled e-mail server would render Laumen et al. unsatisfactory for its intended purpose of recalling or replacing an MMS message that has already been sent. MPEP §2143.01(v) provides “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)) The intended purpose set forth in Laumen et al. (e.g., recalling or replacing an MMS message after it has already been sent) teaches away from any modification to

include sending of a message from a polled e-mail server to a pushed e-mail server.

Independent claim 12 is the apparatus counterpart of method claim 1 and thus patentable over the prior art of record for similar reasons to those described above with respect to claim 1.

Dependent Claim 2 and 15

Claim 2 states “a subscriber account is established for each subscriber on the push mail server, the subscriber account including the telephone number of at least one telecommunication terminal and the original e-mail address of the recipient.” (emphasis added) In Laumen et al. there is no disclosure or suggestion for creating such an account including both pieces of information. There is no need or motivation to create such an account based on the two pieces of information since both service providers are MMS service providers. The Examiner acknowledges that Laumen et al. fails to disclose this limitation but relies on Gabriel et al. as a secondary reference to teach this feature. Gabriel et al. discloses “To use this feature of the system a user can create a regular SMS message in the user’s email program, and addresses the message to the desired recipient’s telephone number at the management server’s address (recipient’snumber@managementserver.com).” {Paragraph [0233]} Thus, in Gabriel et al. the user themselves must address the message to the desired recipient’s telephone number at the management server’s address, whereas in the present claimed invention this function is performed by the push mail server based on the subscriber account. All the user is required to supply with the e-mail message is the recipient’s e-mail address. No teaching or suggestion in either Laumen et al. or Gabriel et al. is found for a subscriber account being established for each subscriber on a push mail sever, wherein “the subscriber account including the telephone number of at least one telecommunication terminal and the original e-mail address of the recipient,” as found in claim 2.

Furthermore, Gabriel et al. discloses a subscriber account including a telephone number (recipient’snumber@managementserver.com) {paragraph [0233]} and that “a user’s account can also be set up to receive SMS messages via email.” {paragraph [0234]} Accordingly, Gabriel et al. discloses the account being based on either the telephone number or the e-mail address, but not both, as called for in claim 2.

Claim 15 contains a limitation similar to that found in claim 2 and thus is patentable over

the prior art of record for at least the same reasons discussed above with respect to claim 2.

Dependent Claim 5

Claim 5 calls for “wherein the push mail server is connected to the MMS or WAP push systems of the employed telecommunication network.” The Examiner maintains that MMS Relay/Server RSB reads on the claimed “push mail server.” The MMS Relay/Server RSB is in fact part of the MMS push system rather than connected to the push system.

For the foregoing reasons, Applicant submits that the claims are patentable over the prior art of record and passage of this application to issuance is therefore requested.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS McLAUGHLIN & MARCUS, P.A.

By



Christa Hildebrand
Reg. No. 34,953
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844
Facsimile: (212)808-0844

001455924CH/CFC